



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

FLOYD B. CHAPMAN
BAKER & BOTTS, LLP
THE WARNER SUITE 1300
1299 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20004-2400

COPY MAILED

MAY 14 2001

**OFFICE OF PETITIONS
A/C PATENTS**

In re application of	:
Scott A. Moskowitz	:
Application No. 08/674,726	: Petition to Expunge
Filed: July 2, 1996	: Dismissed
Atty Docket No. 2377/11	:

The above noted application has been forwarded to the undersigned for consideration of the petition filed on January 24, 2001.

The petition is dismissed.

Petitioner requests that certain comments made by the examiner in paper number 21 be expunged from the record.

After careful consideration, the comments made by the examiner will not be expunged. The Office expunges statements from the Official record only in exceptional circumstances, generally where there is no alternative other than expungement. When a petition to expunge is granted, applicant is required to retain the expunged material and to make it available in any later litigation involving the patent. Accordingly, where trade secret information is not involved, a more suitable alternative to expungement is correction of the record.

In this application, some of the statements made by the examiner were wrong and are regretted.

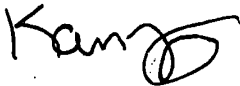
The USPTO spends considerable sums making electronic databases and other information available to examiners for search purposes in examination of applications. Nevertheless, the Office is concerned that for some inventions, the Office may not have access to or be considering all prior public knowledge and publications which would have bearing upon the patentability of these inventions. Any area where information relating to the state of the art is not generally published creates problems for the USPTO in evaluating patents in that area of technology. Applicant has submitted information disclosure statements

with both non-patent literature and prior U.S. patents related to the claimed invention. Some of the patents cited were granted to the inventor of the above-identified application. Clearly, this is an area of technology with prior art available for the examiner to consider, although no blueprints for the inventions yet to be discovered and patented.

Furthermore, contrary to the statement of the examiner, the Office has issued "business method" patents for many years and considered many business methods statutory subject matter before the State Street decision. The "White Paper" cited by applicant describes the Official USPTO policy on business method patents.

After mailing this decision, the application will be returned to Group Art Unit 2664 for further processing, and for consideration of the reply filed March 12, 2001.

Telephone inquiries should be directed to the undersigned at (703) 306-3159.

A handwritten signature in black ink, appearing to read "Karin" followed by a stylized flourish.

Karin L. Tyson
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy